REMARKS

Claims 1-7 and 14-17 are pending. Claims 1-7 and 14-17 are rejected under 35 USC § 103(a) as being unpatentable over Feinleib (US Patent No. 6,272,532) in view of Sharnoff et al. (US Patent No. 6,314,421).

With regard to claims 1 and 14, as stated in the office action, Feinleib does not disclose that the extraction of instructions is done without parsing. Contrary to the statements in the office action, Sharnoff does not disclose extraction of the elements without parsing either. The office action refers to col. 8, lines 11-15, which states, "At block 435, the stored document corresponding to the matched score is retrieved. For one embodiment, the document itself is retrieved, and then parsed into elements. For another embodiment, the elements are retrieved, and no parsing is necessary." This discussion is directed to a choice between two points in time where the parsing is performed. It can either be performed when the document is retrieved (retrieving the whole document), or it can be performed when the document is broken into elements. Otherwise, there would be no elements.

In Sharnoff, the elements are portions of the document, produced by parsing. See col. 6, lines 14-24, which describes the process of parsing the document. While only a portion of the document may be parsed, at least some portion has to be parsed, or there would be no elements to be retrieved.

Further, specific to the process discussed in col. 8, referred to by the office action, it can be seen that the documents have already been parsed prior to the decision to either 're-parse' the document or not. See col. 7, lines 12-29. "At block 410, the document is parsed into elements...At block 415, a score of the element is calculated."

Referring back to col. 8, lines 11-15, it becomes apparent that the documents have to be at least partially parsed into elements and the elements scored, otherwise there would be no way to match a document by score, as is discussed at this point in Sharnoff. Further, the following portion of Sharnoff, col. 8, lines 16-17, it states that, "...an element of the current document is compared to each of the elements of the retrieved document." Again, there would be no elements to use if the document were not parsed.

Therefore, the combination of references does not teach that the instructions are extractable without being parsed.

Further, the combination of references is invalid. "The mere fact that the references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). As the combination of Feinleib and Sharnoff does not

provide any advantage, i.e., the instructions would still have to be parsed, the combination of references is invalid.

It is therefore submitted that claims 1 and 14 are patentably distinguishable over the prior art and allowance of these claims is requested.

Claims 2-7 depend from claim 1, and claims 15-17 depend from claim 14. The dependent claims contain all of the elements of the independent claims. The prior art does not teach all of the elements of the independent claims, much less the further embodiments of the dependent claims. It is therefore submitted that claims 2-7 and 15-17 are patentably distinguishable over the prior art and allowance of these claims is requested.

No new matter has been added by this amendment. Allowance of all claims is requested. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

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